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EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/932,993

Applicant(s)
McKain et al.

Examiner
Luong Nguyen

Art Unit
2612



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 17, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-7, 9-11, 13-17, 19, and 20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 9-11, 13-17, 19, and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Note that this case has been transferred to Examiner Luong Nguyen, Art Unit 2612.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/17/2002 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 4-17, 9-11, 3-17 and newly added claims 19-20 have been considered but are moot in view of the new ground(s) of rejection.

Specification

4. The disclosure is objected to because of the following informalities:

On page 7 (line 28), page 8 (line 3), "camera 31 of Fig. 1" should be changed to --camera 22--.

On page 12 (lines 5-6), "encoder 162" should be changed to --encoder 152--.

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On page 11 (lines 9-21), "media storage 100", "CPU 102", "bus 104", "disk subsystem 100", "memory 104", "flash ROM 106", "dynamic random access memory as shown in 108", "serial I/O controller 110" are not shown in figure 4.

On page 12 (line 4) discloses "bus 109" and on page 13 (lines 21-22) discloses "composite signal 109" and on page 14 (line 8) discloses "output 109". This is confusing.

Further, the "recorder 62" on page 16 (line 14) and "controls 64" are not shown in drawings.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 4, 5, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of these claims, the phrase "on the portable housing" is confusing. For example, the specification discloses a camera which is located in a portable housing. That these claims state that the camera is located "on the portable housing" is confusing. It appears that "in" would be more appropriate than "on". Furthermore, "in the housing" has been recited in claim 1.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-7 and 9-11, 13-16, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al. (US 5,537,157) in view of Freeman et al. (US 5,579,239).

Regarding Claim 1, Washino et al. disclose a digital motion picture recorder comprising a housing sized to be portable for use by an individual (Column 6, Lines 63-64; Column 8, Lines 55-56); a camera mounted in the housing having an output providing a full motion video signal (Figure 2c); a decoder mounted in the housing for receiving a full motion video signal and for converting the full motion video signal into a plurality of digital still images (Figure 2c; Items 50,52), a digital computer-readable and writeable random access medium (Figure 3, Item 70; Figure 4, Item 104) mounted in the housing and connected to receive and store the sequence of digital still images from the decoder in a computer-readable file format and to provide digital still images stored thereon; an encoder mounted in the housing having an input for receiving a sequence of digital still images for generating as an output a full motion video signal (Column 10, Lines 11-18); a switch mounted in the housing having a first input for receiving digital still images from the decoder and a second input for receiving digital still images from the digital computer-readable and writeable random-access medium and an output connected to the input of

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the encoder (See Column 12, Lines 12-23 where such a switch is clearly present); an interface on the housing for causing the switch to provide one of the first and second inputs as the sequence of digital still images to the input of the encoder (See Column 8, Line 65 - Column 9, Line 9 with Column 12, Lines 12-23 and Column 14, Lines 35-53 where such an interface is clearly present);

Washino et al. disclose means, in the housing, for enabling the individual to capture digital still images from the decoder on the digital, computer-readable and writable random-access medium (See Figure 2c, and Figure 3, Column 7, Lines 52-67, Column 8, Lines 55-67, and note that digital signal output from decoders 50, 52 are output as digital video output signals 62 in the format of RGB, then is stored removable hard disk 70); means, in the housing, for enabling the individual to specify a sequence of segments of the plurality of digital still images stored on the digital, computer-readable and writable random-access medium; and means, in the housing, for enabling the individual to initiate playback of full motion video through the switch and the encoder (See Column 14, Lines 46-53 and note that a stored video program may be considered a sequence of segments of the still images since each stored still image of may be considered a segment, i.e. a frame, and a sequence of such segments constitute a program).

Washino et al. fail to specifically disclose to capture digital still images from the decoder into a plurality of data files, wherein each of the plurality of data files stores a sequence of digital still images; and means for enabling the individual to specify a sequence of segments of the plurality of data files. However, Freeman et al. teach a means for capturing full-color, full motion video signal, digitizing and compressing the signal into a digitized data file. And once digitized

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and compressed, the data file is captured in the computer's memory (Column 2, Lines 25-29, Column 3, Lines 1-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Washino et al. by the teaching of Freeman et al. in order to easily retrieve a desired images stored on recording medium.

As to Claim 4, see Examiner's comments regarding regarding Claim 1.

As to Claim 5, see Examiner's comments regarding Claims 1.

As to Claim 6, see Examiner's comments regarding Claim 1.

Regarding Claim 7, Washino et al. disclose a means (Figure 3, Items 72, 74; Figure 4, Items 106, 110) for selectively operating the means for storing to store digital video information corresponding to the received full motion video signal as digital video information or to direct stored digital video information to the first input of the encoder.

Regarding Claim 9, Washino et al. disclose a second encoder having a first input connected to receive stored digital video information from the means for storing and a second input connected to receive digital video information corresponding to the received full motion video signal, and an output for providing an output video signal according to a selected one of the first and second inputs, and a means for causing the second encoder to select from one of the first

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and second inputs (See Figure 4 and note that encoders are supplied for each of a plurality of digital inputs).

Regarding Claim 10, Washino et al. disclose means for receiving and storing on the means for storing digital audio information in a plurality of data files (Column 9, Lines 30-37; Column 12, Lines 4-11); an audio encoder (Figure 4, Item 136) having a first input connected to receive input audio information and a second input connected to receive stored audio information, and an output providing an output audio signal according to a selected one of the first and second inputs, and a means for causing the audio encoder to select from one of the first and second inputs (Column 12, Lines 4-11).

Regarding Claim 11, Washino et al. disclose a first bus (Figure 4; "Digital Inputs") connecting the camera to the first input of the encoder, and a second bus (Figure 4; "Data Bus") connecting the means for storing to the second input of the encoder (See also Column 12, Lines 15-21).

Regarding Claim 13, Washino et al. disclose a media data buffer (Figure 3; Item 72) for receiving a sequence of digital still images from the decoder and for providing the received sequence of digital still images to the digital, computer readable and writeable random-access

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medium and further comprising a processor (Figure 3; Item 74) for controlling data flow between the media data buffer and the digital, computer-readable and writeable random-access medium.

Regarding Claim 14, Washino et al. disclose a first pixel bus (Figure 4; "Digital Inputs") for transmitting a sequence of digital still images from the decoder, and a second pixel bus (Figure 4; "Data Bus") for transmitting a sequence of digital still images from the digital, computer-readable and writeable random-access medium wherein the first pixel bus is connected to the first input of the switch and the second pixel bus is connected to the second input of the switch (See Column 12, Lines 12-23 and Column 14, Lines 45-53 and note that such a connection is clearly present in order to provide art output consisting of images from either of the two sources).

Regarding Claim 15, Washino et al. disclose that the digital, computer-readable and writeable random-access medium is a disk drive having a capacity to store several minutes of sequences of digital still images (Column 8, Lines 34-53).

Regarding Claim 16, Washino et al. disclose a means for storing digital audio information in a plurality of data files on the digital, computer-readable and writeable random-access medium, and for paying back the digital audio information in synchronization with the full motion video signal by the encoder(Column 9, Lines 30-37; Column 12, Lines 4-11).

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As to Claim 20, see Examiner's comments regarding Claim 1.

8. Claims 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al. (US 5,537,157) in view of Freeman et al. (US 5,579,239) further in view of Morita (JP5-153448).

Regarding Claim 17, Washino et al. disclose a digital video recording device comprising a portable housing (Column 6, Lines 63-64; Column 8, Lines 55-56); a camera attached to the portable housing and having an output providing digital live video information (Figures 2a and 3; Column 12, Lines 20, live camera signals); a random access, computer-readable and writeable medium (Figure 3, Item 70; Figure 4, Item 104) mounted within the portable housing; a first encoder (Figure 4; Item 124) mounted within the portable housing having an input for receiving digital video information and an output for providing output video information; a second encoder (Figure 4; Item 120) mounted within the portable housing having an input for receiving digital video information and an output for providing an output video signal to a display (Column 10, Lines 11-21); a first switch mounted within the portable housing and having a first input for receiving live digital video information from the camera and a second input for receiving recorded digital video information from the random access computer-readable and writable medium, and an output connected to provide the digital video information to the input of the first encoder (See Column 12, Lines 12-23 where such a switch is clearly present); a second switch mounted within the portable housing and having a first input for receiving live digital video information from the

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camera and a second input for receiving recorded digital video information from the random access computer-readable and writeable medium, and an output connected to provide the digital video information to the input of the second encoder (See Column 12, Lines 12-23 where such a switch is clearly present).

Washino et al. disclose means, in the portable housing, for enabling a user to capture digital video information from the camera on the random access, computer-readable and writable medium (See Figure 2c, and Figure 3, Column 7, Lines 52-67, Column 8, Lines 55-67, and note that digital signal output from decoders 50, 52 are output as digital video output signals 62 in the format of RGB, then is stored removable hard disk 70); means for enabling the user to specify a sequence of segments of the plurality of digital still images stored on the random access, computer-readable and writable medium; and means, in the housing, for enabling the individual to initiate playback of full motion video by the second encoder (See Column 14, Lines 46-53 and note that a stored video program may be considered a sequence of segments of the still images since each stored still image of may be considered a segment, i.e. a frame, and a sequence of such segments constitute a program).

Washino et al. fail to specifically disclose to capture digital still images from the camera into a plurality of data files; and means for enabling the user to specify a sequence of segments of the plurality of data files. However, Freeman et al. teach a means for capturing full-color, full motion video signal, digitizing and compressing the signal into a digitized data file. And once digitized and compressed, the data file is captured in the computer's memory (Column 2, Lines

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25-29, Column 3, Lines 1-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Washino et al. by the teaching of Freeman et al. in order to easily retrieve a desired images stored on recording medium.

Although it is clear that when the Washino et al. device is employed in a video camera (See Column 8, Lines 55-56) the display must be mounted on the portable housing, but the location of the display in Washino et al. is not specifically disclosed as being on the housing. And Freeman et al. also do not disclose a display mounted on the portable housing. However Morita shows both editing controls and a display on the housing of a camera/editing device (See Figures 2 and 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the display of Washino et al. and Freeman et al. on the portable housing in order to permit the performing of the editing operation in the video camera.

Regarding Claim 19, Washino et al. disclose a means for setting the first switch to allow playback of full motion video from the camera by the first encoder during playback by the second encoder of the sequence of segments from plurality of data files (Column 12, Lines 12-23).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Luong Nguyen** whose telephone number is **(703) 308-9297**. If attempts to

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reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on **(703) 305-4929**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

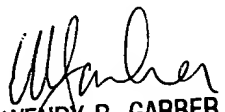
or faxed to:

(703) 872 - 9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

LN LW
8/11/2002


WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600